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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/475,602	12/30/1999	BRYAN J. MOLES	SAMS01-00097	6560

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EXAMINER	
SON, LINH L D	

ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/475,602	BRYAN J. MOLES	
	Examiner	Art Unit	
	Linh LD Son	2135	

-- The MAILING DATE of this communicati n appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is responding to the Amendment received on 03/21/06.

2. Claims 1-20 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351 (a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-13, 15-18, and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Forslow, US/6608832B2.**

5. As per Claims 1, 9, and 17:

Forslow discloses "Common Access Between A mobile communications network and an external network with selectable packet-switched and circuit-switched and circuit-switched services" invention, which includes a wireless,

network (Fig 2), comprising a plurality of base stations (Fig 1 and Fig 2), each of said base stations communicate with a plurality of mobile stations, a security device (Common Access Server 118, Col 15 lines 10-20) capable of preventing an unauthorized workstation from accessing an Internet protocol (IP) Data network through a network (Col 15 lines 15-20), said security device comprising: a first controller (relay agent 120) capable of receiving from said un-provisioned mobile station an IP data packet payload (Col 19 lines 55-67) and *replacing said IP packet header with a replacement IP packet header comprising an IP address of a selected one of at least one provisioning server of said wireless network* (Col 19 line 65 to Col 20 line 20).

6. As per Claims 2 and 11:

Forslow discloses the security device set forth in claims 1 and 9 *where* said first controller is disposed in at least one *of* said plurality *of base* stations (Fig 2).

7. As per Claims 3 and 10:

Forslow discloses the security *device* set forth in *Claim 1* and 9 *wherein said* first *controller is* disposed in a *mobile* switching center of said *wireless* network (Fig 2*)*.

8. As per claims 4, and 12:

Forslow teaches the security device set forth in claim 1 comprising a second controller (GGSN, Col 18 line 64 to Col 19 line 13) capable of

determining that said un-provisioned mobile station is un-provisioned (Col 18 line 64 to Col 19 line 13, and Col 20 lines 20-30).

9. As per claims 5, 13, and 18:

Forslow discloses the security device set forth in Claim 1, wherein said second controller determines that said un-provisioned mobile station is un-provisioned if said un-provisioned mobile station is unable to authenticate to said wireless network (Col 18 line 64 to Col 19 line 13, and Col 20 lines 20-30).

10. As per claims 7, 15, and 20:

Forslow discloses the security device set forth in claims 1,9, and 17 wherein the second controller determines that said unprovisioned mobile station is un-provisioned according to data receive from a home location register associated with said wireless network (Col 18 line 64 to Col 19 line 13, and Col 20 lines 20-30).

11. As per claims 8 and 16:

Forslow discloses the security device set forth in Claim 1 wherein said first controller comprises a data processor capable of executing an encryption program stored in a memory associated with said data processor (Col 20 lines 30-45).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

13. Claims 6, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forslow et al and in view of Henry (US 5,603,084).

14. *As per Claims 6,* 14, and 19:

Forslow teaches *the security device set forth in Claim 1, 9 and 17 and also the second controller and further suggests of different method of intemet remote access, such as GSMICDMAITDMA network and more listed* in Col 10 lines 40-50. However, Forslow does not teach *the step of determining that an un-provisioned mobile station that is unauthorized according to a predetermined telephone number.* Nevertheless, Henry discloses a cellular system connected to PSTN through a mobile switching center (MSC) (Col 5 lines 3-21). The cellular system along with the MSC provides determination of a mobile access rights by using the Mobile Identification Number (MIN) equivalent to a 10 digits telephone number (Col 5 lines 33-49). Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made to

incorporate the teaching of Henry into the second controller on the security device of Forslow to determine the mobile station is authorized/unauthorized based on the telephone number. The incorporation could add another layer of authentication to the wireless network to minimize unauthorized mobile device accessing the network (Col 4 lines 29-59 and Col 5 lines 45-64).

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

16. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. Claims 1-20 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6775285.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

18. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

The following list of claims in application 09/475602, hereinafter "602, are obvious over the claims in the patent US/6775285, hereinafter "285:

09/475602	**US/6775285**
1, 2, 3	1
4	2
5, 6, 13, 14, 19	5, 13
8	6
7, 15, 20	8, 19
9, 10-11	9
12	10

16	14
17	17
18	20

In detail:

19. Regarding claims 1 as exemplary in '602 and claims 1 in '285, recite

Claim 1 in '602	**Claim 1 in '285**
For use in a wireless network comprising a plurality of base stations, each of said base stations capable of communicating with a plurality of mobile stations, a security device capable of preventing an un-provisioned one of said plurality of mobile stations from accessing an Internet protocol (IP) data network through said wireless network, said security device comprising:	For use in association with a wireless network comprising a plurality of base stations capable of communicating with a plurality of mobile stations, an inter-working function unit capable of transferring data between said wireless network and an Internet protocol (IP) data network coupled to said wireless network, said inter-working function unit comprising:
	A protocol conversion controller capable of receiving from said wireless network at first plurality of data packets, wherein said first plurality of data packets are generated

	by a first one of said plurality of mobile stations and are formatted according to a first protocol associated with said wireless network, and converting said first plurality of data packets to a plurality of IP data packets formatted according to an Internet protocol associated with said IP data network; and
A first controller capable of receiving from said unprovisioned mobile station an IP data packet comprising an IP packet header and an IP packet payload and replacing said IP packet header with a replacement IP packet header comprising an IP address of a selected one of at least one provisioning server of said wireless network.	A first security controller for preventing unprovisioned mobile station from accessing said IP data network through said wireless network, wherein said first security controller is capable of receiving at least one of said plurality of IP data packets and replacing an original IP packet header of said at least one IP data packet with a replacement IP packet header comprising an IP address of a selected one of at least one provisioning server coupled to said IP data network and controlled by an operator of said wireless network.

Claim 1 in '602 has similar limitation to claim 1 in '285, except the limitation "A protocol conversion controller capable of receiving from said wireless network at first plurality of data packets, wherein said first plurality of data packets are generated by a first one of said plurality of mobile stations and are formatted according to a first protocol associated with said wireless network, and converting said first plurality of data packets to a plurality of IP data packets formatted according to an Internet protocol associated with said IP data network" would be obvious". Nevertheless, this limitation is obvious over claim 1 in '602 because claim 1 in '602 recites a method of accessing the Internet over a wireless network, which would require converting the communication protocol in the wireless environment to compatibly communicate with the IP communication protocol. Therefore, claim 1 in '602 is obvious over claim 1 in '285.

"The exemplary Claim 1 in '602 is generic to the species of invention covered by claim 1 of the patent '285. "A later patent claim is not patentably distinct from an earlier patent claim if the claim is obvious over the earlier or later claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON

PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Response to Arguments

20. Applicant's arguments filed 03/21/06 have been fully considered but they are not persuasive.

21. As per remark on pages 9 and 10, Applicant argues that Forslow reference does not teach "*a first controller capable of replacing an IP packet header with a replacement IP packet header comprising an IP address of a provisioning server*". Examiner disagrees with the Applicant. The limitation "*a first controller capable of replacing an IP packet header with a replacement IP packet header comprising an IP address of a provisioning server*" in claim 1 recites a method of modifying an IP packet header to include information about a destination of the provisioning server where the unprovisioned mobile station packets should be going to for difference purposes; In this case, Examiner interpreted as for authentication to get mobile services. As cited in both rejection dated on December 15th, 2005, and the amendment remark filed on 03/21/06, the Col 19 line 53 to Col 20 line 20 recites clearly the Examiner's interpretation above for claim 1 limitation "*a first controller capable of replacing an IP packet header with a replacement IP packet header comprising an IP address of a provisioning server*". The first controller (relay agent) modifies the IP address header of the mobile station to include the gateway IP address (giaddr) which is the address that identifies the GGSN (the provisioning server).

22. Therefore, the rejection basis dated 12/15/05 is maintained, including the double patent rejection basis. See above.

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son
Examiner
Art Unit 2135

HOSUK SONG
PRIMARY EXAMINER